Docket No. 0225-4185 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Sholom S. Rosen	Group Art Unit:	2132
Serial No.:	09/314,738	Examiner:	BARRON JR., G.
Filed:	May 19, 1999		

For: ***ELECTRONIC TICKET VENDING SYSTEM***

STATEMENT UNDER 37 CFR § 1.608(b) AND REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Washington, D.C. 22313-1450

Sir:

This paper is filed in response to the Office Action mailed January 26, 2004, which alleges a Requirement for 37 CFR §1.608(b) Statement. More specifically, the Office Action states, in part, the following:

> In accordance with the Board decision of July 7, 2003, the submission of copied claims establishes the written description requirement of 35 USC 112, 1st paragraph for the instant application. However, the priority benefit of applicant's earlier filed parent applications . . . is not granted at this time because the question of whether the disclosure of the ancestral applications meet the written description requirement of 35 USC 112, 1st paragraph was not addressed by the Board Decision and it is the examiner's position, as exemplified in the Examiner's Answer (mailing date December 2, 2002), that the specifications of the parent applications would not provide sufficient disclosure to meet the written description requirement of 35 USC 112, 1st paragraph for the copied claims.
>
> Since the filing date for the instant application is May 19, 1999, which is one year from the date of issue of the Hiroya et al. patent, under 37 CFR 1.608(b), Applicant is required to file evidence . . .which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee and an explaination stating with particularity the basis upon which the applicant is prima facie entitled to the judgment.

As an initial matter, Applicant respectfully requests that the Examiner reconsider and withdraw the Requirement for a 37 CFR § 1.608(b) Statement. The Board's decision has rendered moot the issue as to whether the written description common to the instant application and its ancestors supports the claims presented in the instant application, and there is no outstanding rejection on the merits as to this issue. Accordingly, Applicant respectfully submits that there is no outstanding issue on the merits warranting the Examiner's determination of whether (or not) the 35 USC §112, ¶1, requirements pursuant to the 35 USC §120 priority claim have been met, and, *a fortiori*, Applicant submits that the Examiner's decision to not *grant* the US priority claim made in the instant is procedurally unwarranted and improper.

Applicant, therefore, respectfully submits that based on the US priority claim made in the instant application to the benefit of the filing date of original ancestor application US Serial No. 08/234,461 (through the series of intervening continuation/divisional applications), the instant application should be accorded an effective filing date of April 28, 1994. Because the effective filing date of the instant application is prior to the filing date of the Hiroya patent (even considering the Hiroya patent's 35 USC §119 priority claim to Japanese Application No. 6-284623, filed November 18, 1994), no Rule 608(b) showing (nor a Rule 608(b) statement) should be required by Applicant.

Notwithstanding the foregoing, Applicant respectfully provides the following statements pursuant to the Examiner's requirement under 37 CFR § 1.608(b). Applicant is *prima facie* entitled to a judgment relative to the patentee based at least on the instant application being entitled to the benefit of the April 28, 1994, filing date of

original ancestor application US Serial No. 08/234,461 (now US Patent No. 5,557,518). More specifically, the instant application and the series of ancestor applications identified in the priority claim made in the instant application[1] are evidence that demonstrates that applicant is *prima facie* entitled to judgment *vis-à-vis* the patentee of the Hiroya patent. Throughout the series of continuation and divisional applications, which share a common written description with the original ancestor application, the US priority claim under 35 USC 120 has been properly claimed.

As to the 35 USC 112, ¶1, written description requirement pursuant to 35 USC §120, Applicant respectfully submits that the rule 608(b) showing, (particularly with respect to an explanation stating with particularity the basis upon which the applicant would be entitled to the judgment), is satisfied by Applicant's remarks and explanations as set forth throughout the prosecution of the instant application, which remarks and explanations are incorporated herein by reference. Particularly, these detailed explanations include the specific remarks and explanations detailing how the instant claims are supported by the written description under 35 USC §112, ¶1, thus entitling the instant application to the benefit of the April 28, 1994, filing date of the original ancestor application. For example, Applicant respectfully refers the Examiner to the Request By Applicant For Interference With Patent Under 37 CFR § 1.607, as well as to the Appeal Brief Under 37 CFR § 1.192, annexed hereto as Exhibit A and Exhibit B, respectively.

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[1] In accordance with the priority claim, the present application is a divisional of application Ser. No. 08/895,395 filed Jul. 16, 1997, now U.S. Pat. No. 6,175,921, which is a divisional of application Ser. No. 08/730,158 filed Oct. 23, 1996, now U.S. Pat. No. 5,703,949, which is a continuation of application Ser. No. 08/575,699 filed Dec. 19, 1995, now abandoned, which is a divisional of application Ser. No. 08/264,461 filed Apr. 28, 1994, now U.S. Pat. No. 5,557,518.

Applicant respectfully submits that based on at least the foregoing, a basis upon which the instant application would be entitled to a judgment relative to the patentee has been alleged; namely, a *prima facie* the Rule 608(b) showing has been made.

Applicant maintains, however, as explained above, that the Requirement for a Rule 608(b) showing is improper and should be withdrawn. Further, Applicant respectfully requests that an interference be declared with Applicant named as the Senior Party in the interference.

Respectfully submitted,

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Dated: July 26, 2004 By: _____

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